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09/663,069	09/15/2000	Anandakumar Varatharajah	A-69227/MAK/LM	3198

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EXAMINER

CHANG, SABRINA A

ART UNIT PAPER NUMBER

3625

DATE MAILED: 05/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/663,069

Applicant(s)

VARATHARAJAH,  
ANANDAKUMAR

Examiner

Sabrina Chang

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*ML*

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 15 September 2000.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 5-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 5-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Response to Amendment***

In Paper 8 (7/14/03) the examiner indicated that the applicant's claims as recited were subject to a restriction requirement. The restriction was stated in Paper 8 as follows:

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-8, drawn to a method for manipulating electronic receipt data, classified in class 705, subclass 26.
- II. Claim 9-13, drawn to a method of purchasing goods from a plurality of merchants via various websites, classified in class 705, subclass 26.

Inventions of Group I and Group II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case Group I refers to a method for creating a list of items for use in future transactions while Group II refers to a method of purchasing goods over the Internet from different merchants. Group II does not recite anything relating to the maintenance and usage of electronic receipts.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

In response to the restriction requirement, the applicant traversed the restriction requirement and elected claims 9-13 – Paper 9 (8/13/03). In the examiner's subsequent action – Paper 10 (9/29/03) claims 9-13 were mistakenly withdrawn from the application and only claims

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1-8 were examined on the merits of the application. In his amendment, Paper 11 (2/2/04) the applicant did not acknowledge this mistake. However, in good faith, claims 9-13 have been rejoined to the application and have been fully considered in this office action.

Also, applicant's addition of claims 14-19 and cancellation of claims 3 and 4 have been fully considered.

### ***Response to Arguments***

#### **Improper combination of Cybul and Ojha**

Applicant submits that the combination of the references was improper because Cybul addresses the creation of a shopping list using a customer's previous purchases while Ojha deals with transactions that have not yet occurred. The examiner respectfully asserts that such a combination while not necessarily analogous is still proper.

The applicant's invention recites essentially a method and system for *re-ordering* certain items that have been purchased in the past. Ultimately however, a customer is simply ordering a list of items and allowing his/her peers to review that list.

The spirit of Ojha is to have a customer's friends comment on his/her potential purchases. The method of selecting those items for purchase could have been of *any* nature –straight from a catalog or from the customer's shopping history or from a repository of electronic receipts.

A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor's endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering the problem. In re Clay. 966 F.2d 656, 659, 23 USPQ2d 108, 1060-61 (Fed. Cir. 1992).

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Here even though Ojha teaches the review of a list of products, which have not yet been purchased, the purpose of the invention is to let a consumer get feedback from his/her peers regarding certain product selections. The source of the product list is incidental the invention as a whole and therefore applicant's arguments are not found persuasive.

References fail to teach all the limitations of claim 1

It is conceded that Cybul does not expressly disclose "selecting a first line item" for creation of a new list. However, Cybul does comprise selecting products from a purchase history. There is no need for an explicit disclosure of the specific terms "line items" in the prior art. Selection of products or items is equivalent to such a recitation.

However, the applicant focuses on the failure of Cybul and Ojha to teach the specific use of "electronic receipts" in creating a new shopping list. Examiner respectfully agrees that the arguments as presented in Paper 10 (dated 9/29/03) was not sufficient in addressing this recitation.

For the reasons set forth above, applicant's arguments with regard to claims 1-8 are found persuasive but are moot in view of new grounds of rejection stated below.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 5 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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It is unclear how an order for the first line item is placed – specifically there is no specific recitation of *who* conducts the transaction.

Claim 11 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear what “juxtaposing a reproduction of the first selected goods to a reproduction of the second selected goods” comprises.

Claim 12 recites the limitation “downloading the retrieved electronic record”. There is insufficient antecedent basis for this limitation in the claim.

Claim 13 recites the limitation “the step of retrieving”. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 16 and 17 are rejected under 35 U.S.C. 102(a) as being anticipated by the website [www.receiptcity.com](http://www.receiptcity.com) as taught by the articles “Tech Trends” (May 2000. Progressive Grocer) and “ReceiptCity Teams with Verifone to Bring Retailers Receipt-based e-Services” (April 24, 2000. Business Wire).

Receiptcity is a website where customers can store and access receipts and documents securely. At the end of a transaction at an e-commerce website, that is registered with the

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receiptcity.com service, customers can request an electronic receipt that is sent to a “web vault” [Stock Article, Pg. 2] (participating in a first transaction at a first merchant, thereby generating said first electronic receipt and participating in a second transaction at a second merchant thereby generating a second receipt; a data farm configured to store a first and second electronic receipt from a first and second e-merchant). Customers can access the “vault” and use their electronic receipts to facilitate returns, *product reorders*, warranty claims and charge disputes [Tech Trends, Pg. 1].

Claims 9 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Kraemer.

Kraemer discloses a method and apparatus for providing a unified toolbar across multiple vendor webpages to create an inter-retailer shopping cart” (selecting first and second goods for purchase on first and second websites and paying for first and second goods with one transaction from a consumer perspective) and automate purchases (automatically placing first and second orders) [Abstract].

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 5-8, 17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over the website [www.netgrocer.com](http://www.netgrocer.com) as disclosed in the article “Netgrocer Unveils New Business Model and Launches New Site” (February 10, 1999. Press Release) in view of official notice regarding e-commerce websites and in further view of the website [www.receiptcity.com](http://www.receiptcity.com)

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as taught by the articles “Tech Trends” (May 2000. Progressive Grocer), and “ReceiptCity Teams with Verifone to Bring Retailers Receipt-based e-Services” (April 24, 2000. Business Wire).

Netgrocer is a shopping service that facilitates more efficient purchases of groceries via the Internet. Customers can shop on a website by creating a new list (i.e. going through the website and selecting specific items), selecting items from a saved previous list, or selecting items from their own shopping history (placing an order for selected line items). All three of these options add a level of convenience for the consumer, making shopping fast and efficient [Pg. 2].

Examiner takes official notice here regarding methods of selecting items for purchase on e-commerce website. It is notoriously well-known in the art that websites use “shopping carts” and or “shopping lists” whereby a user can select a plurality of line items, thereby filling their cart or list, and continue shopping until they are ready to purchase all of the items at once. Such a “cart” or “list” is capable of being edited by the user, by any number of well-known means such as adjustment of ordering quantity or deletion from the list.

It therefore would have been obvious to one skilled in the art at the time that the more efficient shopping tools of Netgrocer would allow a shopper to select line items from their purchase history or any list of items, such as a catalog, regardless of source, to create a new shopping list or to “fill their shopping cart”, as taught by official notice, in order to reduce the shopper’s efforts in finding their desired items and make the shopping process more convenient.



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The combination of Netgrocer and official notice does not provide for the creation of electronic receipts at different vendors nor does it allow for a shopper to select from said receipts line items for purchase.

Receiptcity is a website where customers can store and access receipts and documents securely. At the end of a transaction at an e-commerce website, that is registered with the receiptcity.com service, customers can request an electronic receipt that is sent to a “web vault” [Stock Article, Pg. 2]. Customers can access the “vault” and use their electronic receipts to facilitate returns, *product reorders*, warranty claims and charge disputes [Tech Trends, Pg. 1].

In that Netgrocer/official notice provides for the ability of a shopper to reorder items by selecting them from his/her shopping history, it further would have been obvious to one skilled in the art at the time of the invention to create a new shopping list and reorder items by selecting items from a repository of electronic receipt data, as taught by receiptcity.com, or *any* type of repository of historical purchasing data to create a new shopping list in order to facilitate more efficient purchases of a desired item – i.e. reducing the amount of data that needs to be manually entered by the user.

The system of Netgrocer/Official Notice/Receiptcity does not explicitly provide that the newly created list of items can be shared with other persons.

Ojha et al. teaches a method and apparatus for facilitating electronic commerce. Specifically, Ojha allows a potential customer to create a shopping list and share it with friends or co-workers to solicit feedback on various products, sellers, ask prices, etc. [Col 2, Line 63]. The shopping list may be sent in an e-mail, for example as an HTML table or the persons in the group can be given access to the website and can view the product (reproductions of the product)

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[Col 3, Line 1]. The buyer may solicit advice/comment from the group members (viewing and commenting on the list). It would have been obvious to one skilled in the art at the time to modify the system of Netgrocer/Official Notice/Receiptcity to include the ability for a customer to share their shopping lists, as taught by Ojha et al. in order to help facilitate in creating a more reliable and trust buying experience, by soliciting opinions from friends and acquaintances, in order to ensure customer satisfaction and increase the likelihood of future purchases.

### *Conclusion*

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Lee et al. teaches a system and method of managing customer "wish lists." A wish list is a record of information on products he or she wants to buy. The shopper can access the list any time and make one or more transactions for purchasing one or more items stored in their list [Col 1, Line 51]. Wish lists are also accessible to other users [Col 1, Line 65]. Lee et al. does not teach using electronic receipts to form a list.

Tognazzini discloses a digital receipt delivery system, but does not disclose the use of said receipts for anything more than calculation of a consumer's traveling expenses.

Allard et al. discloses a method for engaging in e-commerce where a retailer stores a shopper's active and historic shopping lists. Allard does not disclose the storage or application of electronic receipts.

Hoffman discloses a system, method and apparatus for providing a consumer with the means to access a digital receipt and use said receipt to access various applications. Hoffman was filed in February 2001 and is not prior art.

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European Patent Applications Lyons and Flynn disclose digital receipt generating systems that schedule delivery to consumers or a third party. Lyons and Flynn however were filed in September 2001 and are not prior art.

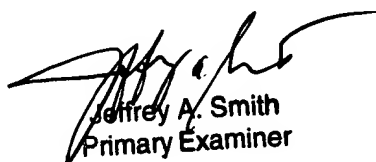
The articles Clark, NCR, Stock, Orenstein, Ferguson, and Sliwa generally discuss the benefits of using electronic receipts. Retailers have an additional channel of access to consumers who have purchased their goods. While the articles discuss a range of applications for use with receipts (e-mails, hyperlinks, automatic warranty registration, etc.) there is no explicit teaching of using electronic receipts to re-order a product. Nor do the articles teach allowing a user to make a list of purchased products available to others.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sabrina Chang whose telephone number is 703 305 4879. The examiner can normally be reached on 8:30 am - 5:30 pm Mon.- Fri..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Smith can be reached on 703 308 3588. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308 1113.

SC



Jeffrey A. Smith  
Primary Examiner